

REMARKS

At the time of the Fourth Office Action dated August 6, 2008, claims 1-24 and 33-35 were pending and rejected in this application.

Applicants have cancelled claims 1-8, 17-24, and 33-35 to remove these claims from further consideration in this application. Applicants are not conceding in this application that those claims are not patentable over the prior art cited by the Examiner, as the present claim amendments and cancellations are only for facilitating expeditious prosecution of the present application. Applicants respectfully reserve the right to pursue these and other claims in one or more continuations and/or divisional patent applications.

**CLAIMS 1-6, 8-14, 16-22, 24 AND 33-34 ARE REJECTED UNDER 35 U.S.C. § 102 FOR
ANTICIPATION BASED UPON YOAKUM ET AL., U.S. PATENT PUBLICATION NO. 2004/0059781
(HEREINAFTER YOAKUM)**

On pages 2-5 of the Fourth Office Action, the Examiner asserted that Yoakum identically discloses the claimed invention the claimed invention. This rejection is respectfully traversed.

The factual determination of anticipation under 35 U.S.C. § 102 requires the identical disclosure, either explicitly or inherently, of each element of a claimed invention in a single reference.¹ Moreover, the anticipating prior art reference must describe the recited invention

¹ In re Rijckaert, 9 F.3d 1531, 28 USPQ2d 1955 (Fed. Cir. 1993); Richardson v. Suzuki Motor Co., 868 F.2d 1226, 1236, 9 USPQ2d 1913, 1920 (Fed. Cir. 1989); Perkin-Elmer Corp. v. Computervision Corp., 732 F.2d 888, 894, 221 USPQ 669, 673 (Fed. Cir. 1984).

with sufficient clarity and detail to establish that the claimed limitations existed in the prior art and that such existence would be recognized by one having ordinary skill in the art.²

"Both anticipation under § 102 and obviousness under § 103 are two-step inquiries. The first step in both analyses is a proper construction of the claims. ... The second step in the analyses requires a comparison of the properly construed claim to the prior art."³ During patent examination, the pending claims must be "given their broadest reasonable interpretation consistent with the specification,"⁴ and the broadest reasonable interpretation of the claims must also be consistent with the interpretation that those skilled in the art would reach.⁵ Therefore, the Examiner must (i) identify the individual elements of the claims and properly construe these individual elements,⁶ and (ii) identify corresponding elements disclosed in the allegedly anticipating reference and compare these allegedly corresponding elements to the individual elements of the claims.⁷ This burden has not been met.

Claim 9

Claim 9 clarifies that the method is performed within a telephone and that the telephone has a first connection to a packet switched network and a second connection to a circuit-switched telephone network. Many of the steps identified by the Examiner, however, are not performed

² See *In re Spada*, 911 F.2d 705, 708, 15 USPQ 1655, 1657 (Fed. Cir. 1990); *Diversitech Corp. v. Century Steps, Inc.*, 850 F.2d 675, 678, 7 USPQ2d 1315, 1317 (Fed. Cir. 1988).

³ *Medichem, S.A. v. Rolabo, S.L.*, 353 F.3d 928, 933 (Fed. Cir. 2003) (internal citations omitted).

⁴ *In re Hyatt*, 211 F.3d 1367, 1372, 54 USPQ2d 1664, 1667 (Fed. Cir. 2000).

⁵ *In re Cortright*, 165 F.3d 1353, 1359, 49 USPQ2d 1464, 1468 (Fed. Cir. 1999).

⁶ See also *Panduit Corp. v. Dennison Mfg. Co.*, 810 F.2d 1561, 1567-68 (Fed. Cir. 1987) (In making a patentability determination, analysis must begin with the question, "what is the invention claimed?" since "[c]laim interpretation, ... will normally control the remainder of the decisional process"); see *Gechter v. Davidson*, 116 F.3d 1454, 1460 (Fed. Cir. 1997) (requiring explicit claim construction as to any terms in dispute).

⁷ *Lindermann Maschinenfabrik GmbH v. American Hoist & Derrick Co.*, 730 F.2d 1452, 221 USPQ 481 (Fed. Cir. 1984).

within telephone 16A, 16B or packet telephone system 32. Instead, these steps are performed with presence system 20. Moreover, neither the telephone 16A, 16B or packet telephone system 32 include a first connection to a packet switched network and a second connection to a circuit-switched telephone network. Thus, Yoakum fails to identically disclose these limitations recited in claim 9.

Claims 10-13

Dependent claim 10 includes the limitation that the claimed telephone includes "selectively placing calls over a circuit-switched telephone network or over the packet-switched network." Under 35 U.S.C. § 102, not only must a prior art reference disclose all elements within a claim, the prior art reference must also disclose those elements "arranged as in the claim."⁸

On page 3 of the Fourth Office Action, the Examiner referred to circuit-switched network 10 and packet-switched network 12 in Fig. 1. However, the Examiner failed to identify a teaching that phone calls are placed over a circuit-switched network or a packet-switched network. Although the telephone 16A, 16B places calls over a circuit-switched network 10 and the packet telephone system 32 places calls over the packet-switched network 12, Yoakum fails to disclose the elements as arranged in the claim. Thus, Yoakum further fails to identically disclose all of the limitations recited in claim 10.

Claim 14

Dependent claim 14 recites "storing user routing preferences based on time-of-day." To teach this limitation, the Examiner identified paragraph [0044] of Yoakum. However, Yoakum

⁸ Cornell v. Sears, Roebuck & Co., 722 F.2d 1542, 1548 (Fed. Cir. 1983).

fails to teach this limitation. Paragraph [0044] does not teach routing preferences based on time-of-day. Instead, this cited passage describes that "individuals in the active list may be changed based on time or date." However, "individuals in the active list" is not comparable to the claimed "routing preferences."

Therefore, for the reasons stated above, Applicants respectfully submit that the imposed rejection of claims 9-14 and 16 under 35 U.S.C. § 102 for anticipation based upon Yoakum is not viable, and hence, Applicants solicit withdrawal thereof.

**CLAIMS 7, 15, 23, AND 35 ARE REJECTED UNDER 35 U.S.C. § 103 FOR OBVIOUSNESS
BASED UPON YOAKUM**

On pages 5 and 6 of the Third Office Action, the Examiner concluded that one having ordinary skill in the art would have been motivated to modify Yoakum to arrive at the claimed invention. This rejection is respectfully traversed.

The Examiner's analysis as to claim 15 is conclusory in nature is not based upon the teachings of the applied prior art. The Examiner has not set forth any common-sense rationale, supported by the teachings of the applied prior art, for making this modification. Therefore, Applicants respectfully solicit withdrawal of the imposed rejection of claim 15 under 35 U.S.C. § 103 for anticipation based upon Yoakum.

Applicants have made every effort to present claims which distinguish over the prior art, and it is believed that all claims are in condition for allowance. However, Applicants invite the Examiner to call the undersigned if it is believed that a telephonic interview would expedite the prosecution of the application to an allowance. Accordingly, and in view of the foregoing remarks, Applicants hereby respectfully request reconsideration and prompt allowance of the pending claims.

Although Applicants believe that all claims are in condition for allowance, the Examiner is directed to the following statement found in M.P.E.P. § 706(II):

When an application discloses patentable subject matter and it is apparent from the claims and the applicant's arguments that the claims are intended to be directed to such patentable subject matter, but the claims in their present form cannot be allowed because of defects in form or omission of a limitation, the examiner should not stop with a bare objection or rejection of the claims. The examiner's action should be constructive in nature and when possible should offer a definite suggestion for correction.

To the extent necessary, a petition for an extension of time under 37 C.F.R. § 1.136 is hereby made. Please charge any shortage in fees due in connection with the filing of this paper, including extension of time fees, to Deposit Account 09-0461, and please credit any excess fees to such deposit account.

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